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EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2622

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/863,997

**Applicant(s)**

SHAW ET AL.

**Examiner**

CHAN S PARK

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 2, is attached to the instant Office action.

### ***Claim Objections***

The following quotations of 37 § CFR 1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

2. Claim 4 recites the limitation "the mailpiece". There is insufficient antecedent basis for this limitation in the claim. The "inverted mailpieces" in the preamble perhaps should be "inverted mailpiece."

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that the print head "prints a first and a second set of one or more markings onto the mailpiece...", claiming that both, the first and the second markings,

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must be printed/present on the same mailpiece. It is unclear whether the mailpiece is fed again in inverted orientation with respect to the previous orientation after printing the first set of marking by the print module so that the second set of marking can be inverted and printed by the inverted print module. It is unclear since the inverted print module only gets the request from the control module only when the mailpiece is in a inverted orientation.

For the examining purposes, Examiner reads the claim as "prints a first or a second set of one or more markings onto the mailpiece."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, 9-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshikawa U.S. Patent No. 6,624,902.

4. With respect to claim 1, Yoshikawa discloses a system for printing markings (fig. 4) along a top and bottom of a mailpiece comprising:

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a print head in a fixed position (print engine 407), where the print head receives print instructions and prints a first or second set of one or more markings onto the mailpiece (col. 6, lines 22-26);

a memory (graphics memory 405) containing data representative of one or more markings (col. 6, lines 20-24);

a print module, coupled to the memory and to the print head, for reading the data representative of the first set of one or more markings from the memory, and converting the data to print instructions that instruct the print head to print the first set of one or more markings onto the mailpiece having a first orientation (S508 in fig. 5);

an inverted print module, coupled to the memory and to the print head, for reading the data representative of the second set of one or more markings from the memory, and converting the data to print instructions that instruct the print head to invert the second set of one or more markings on the print head during printing onto the mailpiece, the mailpiece having a second orientation which is inverted with respect to the first orientation (S509 in fig. 5); and

a control module, coupled to the print module and the inverted print module, for sending marking requests to either the print module or the inverted print module, the marking requests indicating which data representative of one or more markings are to be read from the memory, by the print module or the inverted print module (S507 in fig. 5).

Also read col. 2, lines 25-45 and col. 11, lines 19-30.

Since the system prints the markings on an envelope (col. 11, line 10), it is apparent to one of ordinary skill in the art that an address of a recipient and an address of a sender are printed. Note that the Office interprets these addresses as the first and the second set of markings. Additionally, it is apparent that the addresses are printed along tops and bottoms of the envelope (the sender address on the top and the recipient address on the bottom).

5. With respect to claim 3, Yoshikawa discloses the system of claim 1, wherein the one or more markings are characters, numbers, symbols, graphics, meter indicia, barcodes, POSTNET barcodes, advertisements, and/or advertisement slogans (col. 11, lines 10 & 19-24). The printed addresses include characters and numbers.

6. With respect to claim 4, Yoshikawa discloses a printer for printing markings along tops of an inverted mailpiece comprising:

a print head in a fixed position (print engine 407), where the print head receives print instructions and prints one or more markings onto the mailpiece (col. 6, lines 22-26);

a memory (graphics memory 405) containing data representative of one or more markings (col. 6, lines 20-24);

an inverted print module, coupled to the memory, that receives marking requests and, in response to the marking requests, reads data representative of one or more markings from the memory and inverts the one or more markings on the print head during printing on to the mailpiece, the mailpiece being inverted (S509 in fig. 5).

Also read col. 2, lines 25-45 and col. 11, lines 19-30.

Since the system prints the markings on an envelope (col. 11, line 10), it is apparent to one of ordinary skill in the art that an address of a recipient and an address of a sender are printed. Note that the Office interprets these addresses as the one or more of markings from the memory. Additionally, it is apparent that the addresses are printed along tops and bottoms of the envelope (the sender address on the top and the recipient address on the bottom).

7. With respect to claim 5, Yoshikawa discloses the system of claim 4, wherein the one or more markings are characters, numbers, symbols, graphics, meter indicia, barcodes, POSTNET barcodes, advertisements, and/or advertisement slogans (col. 11, lines 10 & 19-24). The printed addresses include characters and numbers.

8. With respect to claim 6, Yoshikawa teaches a method of printing along tops and bottoms of mailpieces comprising:

printing, with a fixed print head, one or more first markings on a side of a mailpiece, the mailpiece in a first orientation (S508 in fig. 5);

receiving the mailpiece in a second orientation which is about 180 degrees from the first orientation (fig. 2B); and

printing on the side of the mailpiece, with the fixed print head, one or more second markings that are rotated on the print head about 180 degrees from the first orientation of the mailpiece (col. 2, lines 25-45; col. 11, lines 28-30 & S509 in fig. 5).

Since the system prints the markings on an envelope (col. 11, line 10), it is apparent to one of ordinary skill in the art that an address of a recipient and an address

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of a sender are printed. Note that the Office interprets these addresses as the one or more of markings from the memory. Additionally, it is apparent that the addresses are printed along tops and bottoms of the envelope (the sender address on the top and the recipient address on the bottom).

9. With respect to claim 9, Yoshikawa teaches the method of claim 6, wherein the one or more markings are characters, numbers, symbols, graphics, meter indicia, barcodes, POSTNET barcodes, advertisements, and/or advertisement slogans (col. 11, lines 10 & 19-24). The printed addresses include characters and numbers.

10. With respect to claim 10, Yoshikawa teaches a method of printing markings on mailpieces comprising:

transferring mailpieces in an inverted orientation past a fixed print head (fig. 2B);  
and

printing markings on the mailpieces using the fixed print head, wherein the markings are inverted at the print head before printing on mailpieces (col. 2, lines 25-45; col. 11, lines 28-30 & S509 in fig. 5).

11. With respect to claim 11, arguments analogous to those presented for claim 9, are applicable.

12. With respect to claim 12, Yoshikawa discloses a system for printing markings along a top and a bottom of a mailpiece comprising:

a print head (print engine 407) in a fixed position, where the print head receives print instructions and prints one or more markings onto the mailpiece (col. 6, lines 22-26);



a memory (graphics memory 405) containing data representative of a first markings having a first orientation and a second markings having a second orientation (fig. 5); and

a print module, coupled to the memory and to the print head, for receiving marking requests, and based upon the marking requests reading data representative of the first markings or the second markings from the memory, and converting the data to print instructions (S507-S509 in fig. 5).

Also read col. 2, lines 25-45 and col. 11, lines 19-30.

Since the system prints the markings on an envelope (col. 11, line 10), it is apparent to one of ordinary skill in the art that an address of a recipient and an address of a sender are printed. Note that the Office interprets these addresses as the first and the second set of markings. Additionally, it is apparent that the addresses are printed along tops and bottoms of the envelope (the sender address on the top and the recipient address on the bottom).

13. With respect to claim 13, Yoshikawa discloses the system of claim 12 further comprising:

a control module, coupled to the print module for sending marking requests to the print module (S507 in fig. 5).

14. With respect to claim 15, arguments analogous to those presented for claim 3, are applicable.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa as applied to claim 1 above, and further in view of Oshima et al. U.S. Patent No. 5,932,139 (hereinafter Oshima).

15. With respect to claim 2, Yoshikawa discloses the system of claim 1, but it does not disclose expressly a scanner for capturing image data from the mailpiece and an optical character recognition, coupled to the scanner and to the control module, for converting the image data to computer data, where the control module queries a second memory for instructions as to what first set of one or more markings and/or second set of one or more markings are related to the image data.

Oshima, the same field of endeavor of the mailpiece printing, discloses a system comprising:

a scanner for capturing image data from the mailpiece; and  
an optical character recognition, coupled to the scanner and to a control module, for converting the image data to computer data, where the control module queries a memory for instructions as to what barcode information (marking) are related to the image data (col. 51, line 65 – col. 52, line 4).

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At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Yoshikawa.

The suggestion/motivation for doing so would have been to provide a printer that can print the barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine Yoshikawa with Oshima to obtain the invention as specified in claim 2.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa as applied to claim 6 above, and further in view of Oshima.

16. With respect to claim 7, Yoshikawa teaches the method of claim 6, but it does not teach expressly a method of determining address information from the mailpiece and a method of determining the one or more first markings based upon the address information.

Oshima, the same field of endeavor of the mailpiece printing, teaches the method of determining address information (zip) from a mailpiece and determining one or more first markings (barcode information) based upon the address information (col. 51, line 65 – col. 52, line 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Yoshikawa.

The suggestion/motivation for doing so would have been to provide a printer that can print the barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine Yoshikawa with Oshima to obtain the invention as specified in claim 7.

17. With respect to claim 8, Yoshikawa teaches the method of claim 6, but it does not teach expressly a method of determining address information from the mailpiece and a method of determining the one or more second markings based upon the address information.

Oshima, the same field of endeavor of the mailpiece printing, teaches the method of determining address information (zip) from a mailpiece and determining one or more second markings (barcode information) based upon the address information (col. 51, line 65 – col. 52, line 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Yoshikawa.

The suggestion/motivation for doing so would have been to provide a printer that can print the barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine Yoshikawa with Oshima to obtain the invention as specified in claim 8.

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18. With respect to claim 14, arguments analogous to those presented for claim 2, are applicable.

**Conclusion**


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park  
Examiner  
Art Unit 2622

csp  
November 11, 2004

  
EDWARD COLES  
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